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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/092,815	03/07/2002	Thomas R. Fenelon	00-263	7978

719 7590 07/17/2003

CATERPILLAR INC.
100 N.E. ADAMS STREET
PATENT DEPT.
PEORIA, IL 616296490

EXAMINER

CHANG, CHING

ART UNIT	PAPER NUMBER
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3748

DATE MAILED: 07/17/2003

9

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/092,815

Applicant(s)

FENELON ET AL.

Examiner

Ching Chang

Art Unit

3748

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 May 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on May 29, 2003 has been entered (Paper No. 8).

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1 and 9 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Specifically, the limitation "stand alone" directed to the claimed matter "fluid system" and "fluid reservoir" of claims 1 and 9 is new matter. Applicants are required to cancel this new matter in response to this office action.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. ***Claims 1-2, 6-9, and 11-13 are rejected under 35 U.S.C. 102(b) as anticipated by Hu (US Patent No. 5,680,841).***

Hu discloses a fluid system (See Fig. 1) for an internal combustion engine (10), said internal combustion engine including a head assembly (20, 52) having at least one subsystem (30, 32, 40, 60, 70) positioned therein, said fluid system comprising: a fluid reservoir (78); hydraulic fluid (50) contained within said fluid reservoir; and a fluid pump (80) operatively applying said hydraulic fluid to the head assembly and being used solely for actuating the at least one subsystem positioned in the head assembly of the internal combustion engine, wherein said fluid system includes a high pressure fluid manifold (64), wherein said hydraulic fluid is used to actuate an exhaust valve actuation system (30, 32, 40, 60, 70), wherein said exhaust valve actuation system is a compression release brake system (See ABSTRACT; Col. 3, line 29 through line 52), where said hydraulic fluid is used to actuate an intake valve actuation system (30, 32, 40, 60, 70).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. ***Claims 5 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hu (as applied to claims 1 and 9 above) in view of Glassey (US Patent No. 5,191,867).***

Hu discloses the invention as recited above, however, fails to disclose the said subsystem is a fuel injection system.

The patent to Glassey on the other hand, teaches that it is conventional in the hydraulic system application art, to utilize a hydraulic system (20) to actuate a fuel injection system (10, 18).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have utilized the hydraulic system to actuate a fuel injection system as taught by Glassey in the Hu device, since the use thereof would provide an improved fuel injection system for the internal combustion engine.

7. Claims 3-4 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hu (as applied to claims 1-2, and 13/9 above) in view of Bartley (US Patent No. 6,220,521).

Hu discloses the invention as recited above, however, fails to disclose a heat exchanger (or a heater) operatively connected between the fluid pump and the high pressure manifold for a camless engine.

The patent to Bartley on the other hand, teaches that it is conventional in the heat exchanger application art, to utilize a heat exchanger (33) to maintain the hydraulic fluid temperature of a hydraulic system (60) in a camless engine (30).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have utilized a heat exchanger as taught by Bartley in the Hu device, since the use thereof would maintain the hydraulic fluid at an acceptable viscosity during different operating temperatures of the engine.

Response to Arguments

8. Applicant's arguments filed on May 7, 2003 (Paper No. 6) have been fully considered but they are not persuasive.

By referring to Figure 1 of the Applicant's disclosure, the claimed subject matter "a reservoir" in claim 1, labeled as "26", appears to have fluid connections in between the reservoir, "heater 32", and the surroundings. Therefore, the reservoir would not be "a stand alone reservoir", so does the fluid system would not be "a stand alone fluid

system ", too, e.g., but could be a part of transmission fluid system, or power steering fluid system, or brake fluid system, etc.

In addition, this Office would like to reiterate the statement of the Office action mailed on April 14, 2003, -- The reference to Hu reads " the hydraulic fluid may beany other suitable fluid " (See Col. 4, line 12 through line 13), it does teach that it is unnecessary to share such a fluid with an conventional, existing fluid subsystem for an internal combustion engine. In addition, it also discloses the fluid system (See Fig. 1; 50, 52, 80; and Col. 3, line 53 through Col. 4, line 13) operating closely with " the at least one subsystem (30, 32, 40, 60, 70) positioned in the head assembly (52, 20) ". Therefore, the device of Hu is too " used solely for actuating the at least one subsystem positioned in the head assembly " --.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Meistrick (US Patent No. 4,592,319).
- Egan (US Patent No. 4,150,640).

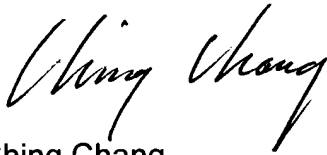
10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ching Chang whose telephone number is (703)306-3478. The examiner can normally be reached on F-M, 7:30 AM -4:30 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas Denion can be reached on (703)308-2623. The fax phone numbers for the organization where this application or proceeding is assigned are (703)872-9302 for regular communications and (703)872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-1148.

Patent Examiner



Ching Chang
July 10, 2003



THOMAS DENION
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700